

REMARKS

Claims 2-4, 6-8, 10, 11, 13-18 and 21-28 are pending in the instant application and stand rejected. Claims 2, 3, 13 and 14 have been amended, and new Claims 30-37 are submitted for consideration by the Examiner. Applicants respectfully request reconsideration and allowance of the pending claims.

Applicants respectfully submit that examination of all pending claims is appropriate. The Office Action refers to the patentable distinctions between a filler and a reinforcement as the basis for the restriction. However, original Claims 12, 13 and 14 recited a reinforcement (it is noted that these claims have been examined twice). The limitations of original Claims 13 and 14 have been added to independent Claims 2 and 3, and Claims 13 and 14 have been amended to further the limitations added to Claims 2 and 3 (i.e., further limit the term reinforcement). Applicants respectfully submit that all of the pending claims are properly examined in the same group and that no undue burden is placed upon the Office in examining these claims together. Such action is respectfully requested.

The rejection of Claims 2-4, 6-8, 10, 11, 13-17 and 20 as being unpatentable over JP 54-33542, Lyons Jr. (USPN 5,263,287), Heimann et al. (USPN 6,017,857), Nee (USPN 4,983,449), Karim et al (USPN 6057382), and Glorieux (USPN 5,399,189), is respectfully traversed.

JP '542 discloses a grease. In contrast, the claimed composition comprises a tape, sheet or film. A skilled person in this art would not equate a grease, which lacks any defined three dimensional quality, to a tape, sheet or film. That is, the function and utility of a grease and a tape are not interchangeable. Similar to JP '542, Heimann is directed to a corrosion resistant lubricant, grease or gel; not a tape, sheet or film.

JP '542 discloses using INERT siliceous fillers. In contrast, the silicates of Heimann are not limited to the inert siliceous fillers of JP '542. That is, the silicates of Heimann are active and can impart increased pH or buffering qualities and, therefore, are not inert as required by JP '542 (e.g., compare Col. 3, Line 62- Col. 4, Line 2 of Heimann to the inert siliceous fillers of JP '542). In light of the incompatible siliceous materials, a skilled person in this art would lack the requisite motivation to combine JP '542 and Heimann.

Nee discloses a protective wrapping material. A skilled person in this art would not equate JP '542's or Heimann's grease to Nee's tape. That is, a grease is applied in a manner distinct from a tape, has no independent configuration, distinct

composition, among other functional and chemical differences. Note also that Nee is concerned with the electrical conductivity of his wrapping material and requires porosity to achieve adequate cathodic protection, e.g., refer to Col 3, Lines 1-5, Col. 4, Lines 59-63, and Col. 6, Lines 30-35 of Nee). The grease of JP '542 lacks any disclosure relating to porosity or conductivity. Converting Nee to a grease or JP '542 to a tape would destroy the respective physical characteristics of the products disclosed in these references (i.e., the presence or absence of a defined three-dimensional structure is mutually exclusive). Consequently a skilled person in this art would not consider Nee as being analogous art to JP '542. Assuming arguendo that Nee and JP '542 are analogous art, Nee relates to protecting a buried metallic pipe (e.g. Col. 1, Lines 1-10 of Nee) whereas JP '542 teaches treating constructions exposed to direct sunlight. Such different applications would cause a skilled person in this art to lack the requisite motivation to combine JP '542 and Nee.

Karim et al. is not available under 35 USC 102(b) against the instant claims. Applicants reserve the right to challenge Karim as being prior art against the claimed invention.

Glorieux relates to a low porosity anticorrosion composition having barrier properties (e.g., refer to the Abstract and Col. 1, Lines 30-35 of Glorieux). In contrast, Nee teaches the value of having porosity so that the underlying pipe can be cathodically protected. The teachings of Glorieux and Nee are conflicting and, therefore, a combination including Glorieux and Nee is inappropriate.

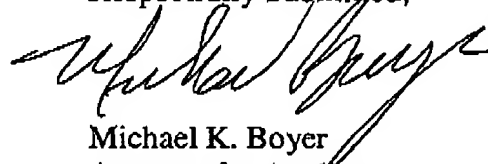
JP '542 and Heimann contain conflicting disclosures, JP '542, Heimann and Nee are incompatible, and Glorieux and Nee teach away from each other. For these reasons, Applicants respectfully submit that a skilled person in this art would lack the requisite motivation to combine these references. Accordingly, Applicants respectfully submit that the applied references cannot be combined to establish a prima facie case of obviousness and, therefore, request withdrawal of this rejection.

This Application is also related to continuing patent application Serial No. 10/375,555 filed on February 26, 2003 (confirmation no 9127). Applicants respectfully request consideration of this patent application as well as the references cited therein.

Applicants believe that the pending claims define patentable subject matter and respectfully request issuance of a Notice of Allowability. Please find attached hereto a Petition for a One Month Extension of Time. Should there be any other fee due in connection with this application, please charge the same to Deposit Account No. 15-0680 (ORSCHEN MANAGEMENT CO.). Should the

Examiner deem that any further action on the part of Applicants would advance prosecution, the Examiner is invited to telephone Applicants' attorney.

Respectfully Submitted,



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